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10/758,036

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Mitsuo Nishizawa

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LE, KHANH H

ART UNIT

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3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/758,036 | Applicant(s) NISHIZAWA, MITSUO | |
| | Examiner KHANH H. LE | Art Unit 3688 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/16/04; 09/22/06; 04/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the original application. Claims 1-17 are pending. Claims 1, 9, and 17 are independent.

Specification

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1, 9 and 17: “the point”, repeated several times, is unclear when many points are involved.

Claims 7 and 15: “estimating points to be paid back” is contradictory to already “calculating” them in claim 9.

Claims 8 and 16: it is not clear what “a **transition** of the total invalidated points for a preset period” means since points cannot transit.

Claims 4-5 and 12-13: “ at the calculating” and “at the invalidating” makes no sense.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17 only cites a computer program i.e. software per se which is non-statutory subject matter. This rejection can be overcome by claiming a computer readable medium encoded with the computer executable program or code which when executed makes the computer performs the steps. See MPEP 2106.01(I).

Note: Claims 1-8 are considered statutory under this section as “units” are interpreted as “units of apparatus”, i.e. hardware, per specifications paragraph [0114].

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3622

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-2, 4-5, 9-10, 12-13, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Luciano Jr. et al. US 6887154, herein Luciano.

Luciano discloses expired points earned by some consumers in any reward schemes (e.g. via games wins-see abstract- or other reward schemes -col.9 lines 52-55-) may be redistributed to other consumers for any purpose (e.g. to fund wins by these latter consumers in different types of games-see abstract, col. 10 lines 22-25 -- or to fund other reward schemes – see col.9 lines 52-55) .

Some relevant portions are excerpted below:

Abstract:

A progressive system (local and wide) where a primary and secondary progressive meter is maintained is disclosed. When a progressive win event occurs, there are two payouts: the first payout (defined by the primary meter) is paid to the player triggering the progressive payout event; the second payout (defined by the secondary meter) is paid to other players (or game devices) having “active” or “enrolled” status at the time of the primary payout event. The present invention provides a method for automating the

*“shared” win, including means for readily determining “active” players. A countdown meter may be used to enable the player a sufficient amount of time to continue play and be considered “active.” Additionally display meters may be used to indicate the status of the player or to warn the player of an imminent change in status. The progressive prizes may be funded using traditional methods (e.g., percentage of wagers, marketing budget). **The progressive prizes may also be funded using expired prizes which have expired or lapsed.***

(Col.9 lines 25-56)

*According to another embodiment of the invention, the system further **provides a prize expiration and reissue module** executed by the central progressive controller or other central server device. According to this embodiment, the player may be awarded one or more prizes, which require redemption. Such prizes may be in the form of points, coupons, game pieces, for example and may require the player to accumulate or collect a certain amount or arrangement of points, coupons, game pieces, etc. The prizes may be awarded to a player using a variety of means, such as via a printed ticket or stored electronically using an account server, for example. **In some cases, a player may not redeem his or her prize. In other cases, the player may not accumulate sufficient points, coupons, credits, etc. to enable the player to qualify for a prize, in which case, the points, coupons, credits, etc. may expire after a lapse period. Various other events may cause, the prizes, points, etc. to expire. The prize expiration and reissue module of the present invention provides a means for tracking these prizes to determine expiration, and upon certain conditions re-issuance of the expired prizes.** According to one embodiment, **the expired prizes are maintained and accumulated by the prize expiration and reissue module and awarded to players of the system upon the occurrences certain events.** The prize expiration and reissue module may accumulate and award the expired prizes as a “secondary progressive prize” which are awarded to and shared by active players as described above. This arrangement provides an enhanced funding scheme for funding prizes for the secondary progressive prize. A similar arrangement may be used to fund the primary progressive prize.*

(Col. 9 lines 47-55)

The expired points arrangement provides that points may be accumulated and earned by a player during normal game play of a gaming device, that the points may expire after certain time periods and/or when other conditions are met, and that the expired points may be re-issued to players in the form of shared progressive awards. In some cases, the points may be awarded pursuant to criteria independent of play of the gaming device (e.g., free promotional points, comp points, etc.)

*To illustrate the an example point system, consider a slot machine version of a gaming device, where one of the reel symbols is a “silver” prize. Depending on the number of “silver” prizes aligning on a wagered payline, a player is awarded a number of “silver” points. The points may be accumulated by the player and once a certain number are collected, the points may be exchanged for a “silver level” prize. **The points may be accumulated, for example, through a database such as a points account system, a player account system, or anonymously through a ticket/voucher system tracking points.** Other prize levels, such as “gold” and “platinum” could also be implemented in a similar manner.*

(Col. 10 lines 1-25)

The points may further have an expiration period, such as thirty (30) days from issuance, for example. As described above, a “prize expiration and reissue module” operating in a local controller device or other central server machine (e.g., a prize server) may be used to track points, including expiration. Once points expire, the points may be added to a pool of points available for payout as a shared progressive prize as described above (i.e., funding the progressive prize). Using the example “silver” prize from above, the progressive triggering event may be five (5) “silver” symbols aligning on a wagered payline with maximum bet. When the progressive win event occurs, the

primary progressive prize may be awarded to the player playing the gaming device triggering the win event, while the accumulated “expired points” may be awarded (re-issued) to “active” players as the shared secondary progressive prize. Upon re-issuance of the points, the expiration period may be reset, establishing a new expiration period for the re-issued points. These points may also expire and be accumulated again into another shared secondary progressive prize. Under this arrangement, the system provides means for utilizing and awarding points which would otherwise have been expired and unused. In yet another alternative arrangement, the expired points may also be used to find the primary progressive prize as well as or instead of the secondary shared progressive prize.

(col. 3 lines 43-50)

The prize expiration and reissue module of the present invention provides a means for tracking these prizes to determine expiration, and upon certain conditions re-issuance of the expired prizes. According to one embodiment, the expired prizes are maintained and accumulated by the prize expiration and reissue module and awarded to players of the system upon the occurrences certain events.

Thus, as to independent claims 1, 9 and 17, Luciano discloses:

an apparatus, method, and executable computer program product for managing a point allotted to each customer for an amount of a purchasing (e.g. citations above: playing a game reads on purchasing a game) and for invalidating the point that is not used within a predetermined period, with the method steps comprising:

calculating total invalidated points from a sum of the points invalidated for all customers (citations above: col.9 lines 25-56)

calculating a point payback to be distributed to each customer (reads on each eligible

Art Unit: 3622

customer) from the total invalidated points (citations, excerpts above); and making a payback of the point calculated to the each customer (citations, excerpts above).

Claims 2 and 10:

Luciano discloses an apparatus or method as in Claims 1 or 9 above and further discloses storing a purchasing history of the each customer, wherein an amount of the points to be paid back to the each customer is calculated based on the purchasing history (Luciano's points redistributed to other consumers for any purpose (e.g. to fund wins by these latter consumers in different types of games-see abstract, col. 10 lines 22-25 -- or to fund other reward schemes -- see col. 9 lines 52-55 read on redistributing based on purchasing history which is commonly a basis for reward schemes; col. 3 lines 8-12: redistribution based on bet amounts reads on the limitation).

Claims 4 and 12:

As best understood from the claim, Luciano discloses an apparatus or method as in Claims 2 or 10 above and further discloses modules to track when points expire per preset expiration conditions and to total accumulated expired points to be redistributed per other preset conditions (Col.9 lines 25-56).

Claims 5 and 13:

Luciano discloses an apparatus or method as in Claims 4 or 12 above and further discloses wherein at the invalidating, the points that are not used for the predetermined period are invalidated if the customer makes no purchasing within the predetermined period.(Luciano discloses "*In some cases, a player may not redeem his or her prize. ...in which case, the points, coupons, credits, etc. may expire after a lapse period. Various other events may cause, the prizes, points, etc. to expire.*" which reads on the claim.)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 6-8, 11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano in view of Official Notice.

Claims 3 and 11:

Luciano discloses an apparatus or method as in Claims 2 or 10 above and but does not specifically disclose wherein the purchasing history includes a purchasing date of a product, and the amount of the points to be paid back to the each customer is calculated by scoring the each customer according to number of days passed since the purchasing date to a next purchasing date and multiplying the total invalidated points by a ratio of a score of the each customer to a sum of scores of all customers.

Official Notice is taken that reward schemes based on frequency of purchases or date of purchase is old and well-known. For example JP 2001-236573, cited in the Japanese Office Action supplied by Applicants, discloses granting benefits according to a purchase amount, a purchase frequency, and the like.

Thus it would have been obvious to a PHOSITA redistribute points as rewards as taught by Luciano based on frequency of purchases as taught by JP 2001-236573 or as well-known in the art, since the combination of old known elements have been held as obvious by the Supreme

Court in KSR. . See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register / Vol. 72, No. 195, Wednesday, October 10, 2007 Notices, <http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf> (herein “Guidelines”) for rationales against non-obviousness.

Official Notice is also taken that scoring (or evaluating, weighing using some metric that can be called value, parameter, factor or score) actual or potential customers for their consumption potential is known. Thus it would have been obvious to a PHOSITA to score a consumer based on frequency of purchases if the latter is a basis for evaluation.

As to multiplying the total invalidated points by a ratio of a score of the each customer to a sum of scores of all customers to arrive at the points to redistribute to a consumer, Luciano discloses redistributing among a pool of distributees by equal shares or per some criteria (col. 3 lines 8-12).

In view of the teachings as to scoring in the prior art and Luciano’s redistribution methods as discussed above, a PHOSITA could easily have adopted the particular simple formula claimed to impart some rationality and fairness in the points redistribution. The calculation method to be adopted is merely a matter of choice, (which could be dictated by market forces or design incentives, that have been found to be obvious in KSR) to be appropriately made by those skilled in the art.

Claims 6 and 14:

Luciano discloses an apparatus or method as in Claims 1 or 9 above but does not specifically disclose outputting the total invalidated points calculated (this is as best understood from the claim), though Luciano discloses tracking the expirable and expired points (e.g. col. 5 lines 6-12).

However, in view of well-known computer processing and display techniques, and the level of skill in the art as evidenced by Luciano, it would have been obvious to a PHOSITA to

Art Unit: 3622

output as claimed to apprise at least the Luciano's system operator of the status of the total points to be distributed.

Claims 7 and 15:

Luciano discloses an apparatus or method as in Claims 6 or 14 above but does not disclose estimating the points to be paid back to the each customer based on the information on the accumulation status of the total invalidated points, and outputting such information. However in view of the teachings of Luciano above, and in view of the level of skill in the art as to data processing and transmission, if it is desired to apprise the customer of such information, e.g. to maintain customer interest in the program, a PHOSITA could easily and would have calculated and provided such information to the customer.

Claims 8 and 16:

If "a transition of the total invalidated points for a preset period" means an increase in such in a preset period, Luciano discloses an apparatus or method as in Claims 6 or 14 above but does not disclose calculating or displaying such.

However, in view of well-known computer processing and display techniques, and the level of skill in the art as evidenced by Luciano, it would have been obvious to a PHOSITA to output as claimed to apprise at least the Luciano's system operator of the status, or the increase or decrease of the total points to be distributed in a preset period.

Such calculation and display could and would obviously have been made if desired. See Guidelines, cited above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*JP 2002-304588 describes counting expired points and granting the points to preferential customers as bonus points by a predetermined method.

Translation of *JP 2000-268094 describes distributing expired points to shops (e.g. [0112]).

Pearson 20060129426 discloses points earned/ purchases, expired points divided among community members per some formula (equally or not); points expiring after certain period (Fig 14).

Sakakibara US 6721743 discloses adding up small amounts for some purpose.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Khanh H. Le/

Examiner, Art Unit 3688

March 31, 2008

/Eric W. Stamber/

Supervisory Patent Examiner, Art Unit 3622